UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/847,642	05/01/2001	Luciano Lavagno	CA7012162001	6620

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VISTA IP LAW GROUP LLP
1885 Lundy Avenue
Suite 108
SAN JOSE, CA 95131

EXAMINER
GUILL, RUSSELL L

ART UNIT	PAPER NUMBER
2123	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	09/847,642	LAVAGNO ET AL.
	Examiner	Art Unit
	Russ Guill	2123

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>17 November 2008</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1,2,4-22,33,34 and 36-60</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1,2,4-22,33,34 and 36-60</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>27 July 2001</u> is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

DETAILED ACTION

1. This Office Action is in response to an amendment filed November 17, 2008. No claims were added or canceled. Claims 1 – 2, 4 – 22, 33 – 34 and 36 – 60 are pending. Claims 1 – 2, 4 – 22, 33 – 34 and 36 – 60 have been examined. Claims 1 – 2, 4 – 22, 33 – 34 and 36 – 60 are rejected.

2. A call was placed to the Applicant on Thursday, December 18, 2008, to discuss claim amendments, but no return call was received by Wednesday, December 24, 2008. Thus, a final Office action is sent.

Response to Remarks

3. Regarding claims 9 and 41 rejected under 35 USC § 112, first paragraph:

   3.1. Applicant's arguments are persuasive; however, the amendment has raised new issues under 35 USC § 112, first paragraph, and the claims are rejected below.

4. Regarding claims 1, 9, 33, 41 and 55 rejected under 35 USC § 103:

   4.1. Applicant's arguments are persuasive.

Claim Objections

5. Claims 1, 9, 55 are objected to: a valid process under 35 USC § 101 must either 1) transform underlying subject matter, or 2) be tied to another statutory class, such as a <u>particular apparatus</u>. In order to qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplishes the method steps. A recitation of a computer in the preamble does not appear to be sufficient to tie the process to a

particular apparatus. The clarity of the claim would benefit by explicitly reciting a tie to another statutory class in order to avoid potential claim interpretations that would be non-statutory.

6. Claim 41 is objected to: the claim recites in lines 1 – 2, "tangible volatile or non-volatile medium useable by a processor". The clarity of the claim would benefit by replacing the phrase with, "computer useable storage medium", in order to avoid potential claim interpretations that would be non-statutory. Please note that the amendment would require "said processor" in line 8 to be amended to, "a processor".

7. Claim 41 is objected to: the claim recites in line 8, "into simulation model". The clarity of the claim would benefit by replacing the phrase with, "into *the* simulation model".

8. Claim 55 is objected to: the claim recites in line 20, "tangible computer readable medium". The clarity of the claim would benefit by replacing the phrase with, "computer useable storage medium", in order to be consistent with the language of the specification.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

a. Claims 1 – 2, 4 – 22, 33 – 34, 36 - 60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in

such a way as to reasonably convey to one skilled in the relevant art that the
inventor(s), at the time the application was filed, had possession of the claimed
invention.

> i.   Regarding claim 41, the claim recites in lines 7 – 8, "generating a
> simulation model by disassembling a binary code into simulation model
> in a high level language format". This subject matter was not described in
> the specification in such a way as to reasonably convey to one skilled in
> the relevant art that the inventor(s), at the time the application was filed,
> had possession of the claimed invention. The invention does not appear
> to disassemble binary code into a simulation model as recited in the claim;
> rather, the specification appears to recite that binary code is disassembled
> into assembler, which is then provided to the translator (*specification, page
> 6, lines 7 – 8*). The MPEP recites (section 2163), "when filing an
> amendment an applicant should show support in the original disclosure
> for new or amended claims."
>
> ii.   Regarding claim 55, the claim recites in lines 8 – 11, "processing the
> data structure to refine accuracy of an assembler-level software simulation
> model by generating the assembler-level software simulation model based
> on the assembly language software module by using the assembly
> language software module or by *disassembling a binary code*". This subject
> matter was not described in the specification in such a way as to
> reasonably convey to one skilled in the relevant art that the inventor(s), at
> the time the application was filed, had possession of the claimed
> invention. The invention does not appear to perform the recited process
> by disassembling a binary code; rather, the specification appears to recite
> that binary code is disassembled into assembler, which is then provided to
> the translator (*specification, page 6, lines 7 – 8*).

iii.   Regarding claim 1, the claim recites in lines 11 – 12, "generating a software simulation model based at least in part upon the assembler code by disassembling a binary code". This subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. When a binary code is disassembled, the generated software simulation model does not appear to be based upon the assembler code that was created in the preceding limitations.

iv.   Regarding claim 9, the claim recites in lines 5 - 7, "generating a software simulation model by disassembling a binary code into the software simulation model in a high level language format". This subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The invention does not appear to disassemble binary code into a simulation model as recited in the claim; rather, the specification appears to recite that binary code is disassembled into assembler, which is then provided to the translator (*specification, page 6, lines 7 – 8*).

v.   Regarding claim 33, the claim recites in lines 13 – 14, "generating a software simulation model based at least in part upon the assembler code by disassembling a binary code". This subject matter was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. When a binary code is disassembled, the generated software simulation model does not appear

to be based upon the assembler code that was created in the preceding limitations.

vi.   Dependent claims inherit the defects of their parent claims.

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10.1.   Claims 1 – 2, 4 – 22, 33 – 34, 36 - 60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

10.1.1. Regarding claim 1, the claim recites in lines 17 - 18, "the act of generating a software simulation model by translating the assembler code or disassembling a binary code". The term appears to have insufficient antecedent basis.

10.1.2. Regarding claim 1, the claim recites in lines 16 - 18, "the act of annotating the software simulation model is performed during a time when the act of generating a software simulation model by translating the assembler code or disassembling a binary code". The phrase appears to be grammatically incorrect, and thus the meaning is unclear. The metes and bounds of the claim cannot be determined.

10.1.3. Regarding claim 9 the claim recites in lines 10 - 13 "the act of annotating the software simulation model is performed during a time when the act of generating a software simulation model by disassembling a binary code into the software simulation model". The phrase appears to be grammatically

incorrect, and thus the meaning is unclear. The metes and bounds of the claim cannot be determined.

10.1.4. Regarding claim 16, the claim recites, "the translating step". The term appears to have insufficient antecedent basis.

10.1.5. Regarding claim 33, the claim recites in lines 18 – 20, "the act of annotating the software simulation model is performed during a time when the act of generating a software simulation model by disassembling the binary code". The phrase appears to be grammatically incorrect, and thus the meaning is unclear. The metes and bounds of the claim cannot be determined.

10.1.6. Regarding claim 41 the claim recites in lines 12 – 14, "the act of annotating the software simulation model is performed during a time when the act of generating a software simulation model by disassembling a binary code into the software simulation model". The phrase appears to be grammatically incorrect, and thus the meaning is unclear. The metes and bounds of the claim cannot be determined.

10.1.7. Regarding claim 41, the claim recites in lines 13 – 14, "the act of generating a software simulation model". The term appears to have insufficient antecedent basis.

10.1.8. Regarding claim 55 the claim recites in lines 16 – 18, "the act of associating is performed during a time when the act of parsing the assembly language software into a data structure". The phrase appears to be grammatically incorrect, and thus the meaning is unclear. The metes and bounds of the claim cannot be determined.

10.1.9. Regarding claim 33, the claim recites in line 12, "performing a
performance analysis using the assembler code". This limitation appears to
be independent of the remaining limitations, and does not appear to
contribute to the claim, and thus the purpose of the limitation is unclear.
The scope of the claim is indefinite. The most recent claim amendments
appear to have removed the reference to the performance analysis from the
following limitation.

10.1.10.   Regarding claim 1, the claim recites in line 10, "performing a
performance analysis using the assembler code". This limitation appears to
be independent of the remaining limitations, and does not appear to
contribute to the claim, and thus the purpose of the limitation is unclear.
The scope of the claim is indefinite. The most recent claim amendments
appear to have removed the reference to the performance from the
following limitation.

10.1.11.   Regarding claim 9, the first limitation recites a step of obtaining a
software assembly code module. The first limitation appears to be
independent of the remaining limitations, and does not appear to contribute
to the claim, and thus the purpose of the limitation is unclear. The scope of
the claim is indefinite.

10.1.12.   Regarding claim 41, the first limitation recites a step of obtaining a
software assembly code module. The first limitation appears to be
independent of the remaining limitations, and does not appear to contribute
to the claim, and thus the purpose of the limitation is unclear. The scope of
the claim is indefinite.

10.1.13.   Dependent claims inherit the defects of their parent claims.

Allowable Subject Matter

11. Any indication of allowability is withheld pending resolution of the outstanding
rejections.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this
Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37
CFR 1.136(a).

13. A shortened statutory period for reply to this final action is set to expire THREE
MONTHS from the mailing date of this action. In the event a first reply is filed
within TWO MONTHS of the mailing date of this final action and the advisory
action is not mailed until after the end of the THREE-MONTH shortened statutory
period, then the shortened statutory period will expire on the date the advisory
action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be
calculated from the mailing date of the advisory action. In no event, however, will
the statutory period for reply expire later than SIX MONTHS from the date of this
final action.

14. Any inquiry concerning this communication or earlier communications from the
examiner should be directed to Russ Guill whose telephone number is 571-272-7955.
The examiner can normally be reached on Monday – Friday 10:00 AM – 6:30 PM.

15. If attempts to reach the examiner by telephone are unsuccessful, the examiner's
supervisor, Paul Rodriguez can be reached on 571-272-3753. The fax phone number
for the organization where this application or proceeding is assigned is 571-273-

8300. Any inquiry of a general nature or relating to the status of this application
should be directed to the TC2100 Group Receptionist: 571-272-2100.

16. Information regarding the status of an application may be obtained from the Patent
Application Information Retrieval (PAIR) system. Status information for published
applications may be obtained from either Private PAIR or Public PAIR. Status
information for unpublished applications is available through Private PAIR only.
For more information about the PAIR system, see http://pair-direct.uspto.gov.
Should you have questions on access to the Private PAIR system, contact the
Electronic Business Center (EBC) at 866-217-9197 (toll-free).

                                        Russ Guill
                                        Examiner
                                        Art Unit 2123
RG

                        /Paul L Rodriguez/
                        Supervisory Patent Examiner, Art Unit 2123